REMARKS

Claims 1-30 are pending in the present application.

This Amendment is in response to the Office Action mailed March 5, 2003. In the Office Action, the Examiner rejected claims 1-5 and 11-15 under 35 U.S.C. §102(b); and claims 6-10 and 16-30 under 35 U.S.C. §103(a). Applicants have amended claims 1, 11, and 21. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

I. REJECTION UNDER 35 U.S.C. §102(b) AND §103(a)

In the Office Action, the Examiner rejected claims 1-5 and 11-15 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,996,061 issued to Lopez-Aguado et al. ("Lopez-Aguado"). In addition, the Examiner rejected claims 6-10 and 16-30 under 35 U.S.C. §103(a) as being unpatentable over Lopez-Aguado in view of U.S. Patent No. 6,134,633 issued to Jacobs ("Jacobs"). Applicants respectfully traverse the rejection and contends that the Examiner has not met the burden of establishing a prima facie case of anticipation and obviousness.

Applicants reiterate the arguments set forth in the previously filed Response to the Office Action.

Lopez-Aguado does not disclose, either expressly or inherently, suggest, or render obvious a gating circuit to disable the access request when it matches to at least P of the stored prefetch address. In the Office Action, the Examiner stated that "to terminate prefetching based upon the determination that an address is in the prefetch queue in Lopez-Aguado, a signal to terminate must be sent or not sent (switched) based upon a control signal (address in the queue); this is the basic definition of a gating circuit." Applicants respectfully disagree.

First, for a rejection based on anticipation, the prior art reference must teach every limitation of the claim. Here, Lopez-Aguado does not disclose a gating circuit and merely teaches that "if the derived prefetch address is already stored within the prefetch queue 150, prefetching is terminated." Lopez-Aguado does not disclose a signal to terminate, nor a control signal, as contemplated by the Examiner.

Second, the Examiner failed to provide any evidence of a definition of a gating circuit. A gating circuit is used to gate other signals. The gating may be any logic function, such as AND

or OR. If a gating circuit is defined simply as sending a signal based on another control signal, why is it necessary to provide a gating circuit?

Third, Lopez-Aguado does not disclose the prefetch address. Lopez-Aguado instead discloses a "derived prefetch address" which is derived from the extracted physical address by adding a stride to the extracted physical address (Lopez-Aguado, Col. 7, lines 18-20).

Fourth, Lopez-Aguado does not disclose or suggest when the access request matches to at least P of the stored prefetch addresses. Lopez-Aguado merely discloses "if the derived prefetch address is already stored within the prefetch queue ...". In other words, Lopez-Aguado is only concerned with the presence or absence of the derived prefetch address, not with whether the access request matches to at least P of the stored prefetch addresses. This determination is far different than merely a determination of the presence of the derived prefetch address because it also determines the number of matches.

To anticipate a claim, the reference must teach every element of a the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion or motivation to combine the references. "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with

no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re ROUFFET, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985).

Therefore, Applicants believe that independent claims 1, 11, 21 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejections under 35 U.S.C. §102(b) and §103(b) be withdrawn.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

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Tu Nguyen — *6/5/03 Date*